UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,039	01/29/2004	Hiroyuki Hatta	1538.1045	2575

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

Office Action Summary	Application No.	Applicant(s)
	10/766,039	HATTA ET AL.
	Examiner	Art Unit
	Wilson Lee	2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>16 October 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-19</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-19</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>9/10/07</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 08-06)   Office Action Summary   Part of Paper No./Mail Date 20071223

Response to Arguments

Applicant's arguments filed 10/16/2007 have been fully considered but they are not persuasive.

Applicant argues that Whitman fails to disclose "extracting data of documents corresponding to the display item selected by the user from the storage or the data of the plurality of documents."

Examiner is not persuaded.

Fig. 8 of Whitman displays the results (810, 820) of the search extracting from the storage (133) (Also see Col. 6, lines 1-15). The user can select (or simply click on) them then the content (data) of the results (documents) will be extracted and displayed on the screen.

Applicant argues that Whitman fails to meet the limitation of claim 2 because Whitman fails to disclose "the second.. third.. fourth.. fifth form" and "receiving, before said second transforming,.." as cited in claim 2.

However, Examiner is not persuaded.

Since applicant has included the term **"at least one of"** in line 2, therefore only either one of the following forms and limitations is required. Whitman does not need to include all of the limitations "the second.. third.. fourth.. fifth form" and "receiving, before said second transforming,.." in order to anticipate claim 2.

Since Whitman clearly teaches the first form showing indications of extracted documents (recent set of query) that have been classified by used words (search

phrases previously-submitted) in said extracted documents (Col. 2, lines 13-40), thus

Whitman meets the claimed invention of claim 2.

Claim Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12, 14, 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated

by Whitman et al. (6,772,150).

Regarding Claim 1, Whitman discloses a computer-implemented search

processing method, comprising:

- searching a predetermined document group according to a first search

    condition specified by a user to extract data of a plurality of documents

    from a storage (133) that stores said predetermined document group

    (Fig. 8 and Col. 1, lines 15-44, Col. 6, lines 1-15, Col. 6, lines 58-68; Col.

    7, lines 1-12 and Col. 14, lines 13-22);

- transforming said data of said plurality of documents into information to

    indicate said data of said plurality of documents to said user in a first

    display form and to enable said user to select a display item to be utilized

    as a second search condition (refining the query, Col. 1, lines 53-62 and

Col. 3, lines 39-55) in a following processing, and outputting the

transformed information (810, 820) (Fig. 8 and Col. 7, line 59 to Col. 8,

line 5 and Col. 14, lines 13-22);

- extracting data of documents corresponding to said display item selected

by said user from the storage (133) or the data of the plurality of

documents (Abstract and Col. 2, lines 25-40 and Col. 3, lines 39-57, Col.

4, lines 1-7 and Col. 5, lines 44-64, Col. 6, lines 1-15); and

- transforming said data of said documents corresponding to said selected

display item into information to indicate said data of said documents to

said user in a second display form (refining the query, Col. 1, lines 53-62

and Col. 3, lines 39-55) specified by said user and to enable said user to

select a display item to be utilized as a third search condition in a

following processing ("refining" can be more than two), and outputting the

transformed information (Fig. 8, and Col. 7, line 59 to Col. 8, line 5 and

Col. 14, lines 13-22).

Regarding Claim 2, Whitman discloses that a first form showing indications of

extracted documents (recent set of query) that have been classified by used words

(search phrases previously-submitted) in said extracted documents (Col. 2, lines 13-40)

Regarding Claim 3, Whitman discloses that the first transforming comprises:

- dividing said plurality of documents into clusters (Related Searches, Top

Matches, Full Results) by using said data of said plurality of documents

(fig. 8);

- extracting second data to be displayed from said data of said plurality of documents, wherein a type of the extracted second data is predefined for said first display form (Abstract and Col. 2, lines 25-40 and Col. 3, lines 39-57, and Col. 4, lines 1-7 and Col. 5, lines 44-64); and

- generating, for each said cluster, information to display the extracted second data to be utilized as said second search condition in said following processing (Fig. 8 and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22).

Regarding Claim 4, Whitman discloses that the first transforming comprises:

- calculating (selection process) a degree of relevancy (relevant item) between said plurality of documents by using said data of said plurality of documents (Col. 1, lines 15-24; Col. 7, lines 26-44);

- extracting, for each of said plurality of documents a data item to be displayed from said data of said plurality of documents, wherein a type of said data item is predefined for said first display form (Abstract and Col. 2, lines 25-40 and Col. 3, lines 39-57 lines 1-7 and Col. 5, lines 44-64); and

- generating information to display the extracted data items to be utilized as said second search condition in said following processing in said following processing, and a segment that connects between said data items (search key term and document must be linked in order to display the item) and represents the calculated degree of relevancy between

said documents corresponding to said data items (Fig. 8, and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22).

Regarding Claim 5, Whitman discloses dividing said plurality of documents into classes (Related Searches, Top Matches, Full Results) based on used words included in said data of said plurality of documents (fig. 8), and counting a number of documents in each said class based on a specific matter predefined for said first display form (figs. 1, 8); and generating information to display the counting result (figs. 1, 8).

Regarding Claim 6, Whitman discloses that the first transforming comprises:

- calculating (selection process) a degree of relevancy (relevant item) between used words included in said data of said plurality of documents (Col. 1, lines 15-24; Col. 7, lines 26-44); and

- generating information to display said used words to be utilized as said second search condition in said following processing, and a segment that connects between said used words (search key term and document must be linked in order to display the item) and represents the calculated degree of relevancy between said used words (Fig. 8 and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22).

Regarding Claim 7, Whitman discloses first transforming comprises:

- relating said plurality of documents into document groups (Related Searches, Top Matches, Full Results) based on a specific matter predefined for said first display form (fig. 8);

-      calculating (selection process) a degree of relevancy between said

document group and a used word included in said data of said plurality of

documents (Col. 1, lines 15-24; Col. 7, lines 26-44); and

-      generating information to display said document groups by said data of

said specific matter, and the calculated degree of relevancy (relevant

item) between said document group and said used word by a segment

connecting between said document group and said used word (search

key term and document must be linked in order to display the item),

wherein said document group and said used word are to be utilized as

said second search condition in said following processing (figs. 1, 2, 8).

Regarding Claim 8, Whitman discloses that the second transforming comprises:

-      dividing said documents corresponding to said selected display item into

clusters (Related Searches, Top Matches, Full Results) by using said

data of said documents corresponding to said selected display item (fig.

8);

-      extracting third data to be displayed from said data of said documents

corresponding to said selected display item, wherein a type of the

extracted third data is predefined for said second display form (Abstract

and Col. 2, lines 25-40 and Col. 3, lines 39-57 lines 1-7 and Col. 5, lines

44-64); and

-      generating, for each said cluster (Related Searches, Top Matches, Full

Results, information to display the extracted third data to be utilized as

said third search condition (refining search can be more than two) in said

following processing (figs. 1, 2, 8).

Regarding Claim 9, Whitman discloses second transforming comprises:

- calculating (selection process) a degree of relevancy between said

  documents corresponding to said selected display item by using said

  data of said documents corresponding to said selected display item (Col.

  1, lines 15-24; Col. 7, lines 26-44);

- extracting, for each said documents corresponding to said selected

  display item, a data item (810, 820) to be displayed (fig. 8) from said data

  of said documents corresponding to said selected display item wherein a

  type of the second data item is predefined for the second display form

  (refining the query, Col. 1, lines 53-62 and Col. 3, lines 39-55) (Abstract

  and Col. 2, lines 25-40 and Col. 3, lines 39-57 and Col. 4, lines 1-7 and

  Col. 5, lines 44-64); and

- generating information to display the extracted second data (refined)

  items to be utilized as said third search condition in said following

  processing (refining search), and a segment that connects between said

  second data items (search key term and document must be linked in

  order to display the item) and represents the calculated degree of

  relevancy between said documents corresponding to said selected

  second data (figs. 1, 2, 8 and Col. 6, lines 1-28).

Regarding Claim 10, Whitman discloses that second transforming comprises:

-        dividing said documents corresponding to said selected display item into

classes (Related Searches, Top Matches, Full Results) based on used

words included in said data of said documents corresponding to said

selected display item (fig. 8), and

-        counting a number of documents in each said class based on a specific

matter predefined for said second display form (figs. 1, 2, 8); and

generating information to display the counting result (figs. 1, 2, 8).

Regarding Claim 11, Whitman discloses that said second transforming

comprises:

-        calculating a degree of relevancy between used words included in said

data of said documents corresponding to said selected display item (Col.

1, lines 15-24; Col. 7, lines 26-44); and

-        generating information to display said used words to be utilized as said

third search condition (refining search can be more than two) of said

following processing (Fig. 8 and Col. 7, line 59 to Col. 8, line 5 and Col.

14, lines 13-22), and a segment (search key term and document must be

linked in order to display the item) that connects between said used

words and represents the calculated degree of relevancy between said

used words (figs. 1, 2, 8).

Regarding Claim 12, Whitman discloses that said second transforming

comprises:

- categorizing said documents corresponding to said selected display item into document groups (Related Searches, Top Matches, Full Results) based on a specific matter predefined for said second display form (fig. 8);

- calculating (selection process) a degree of relevancy between said document group and a used word included in said data of said documents corresponding to said selected display item (Col. 1, lines 15-24; Col. 6, lines 16-29 and Col. 7, lines 26-44); and

- generating information to display said document groups by said data of said specific matter (810 in Fig. 8 and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22), and the calculated degree of relevancy (relevant item) between said document group and said used word by a segment (search key term and document must be linked in order to display the item) connecting between said document group and said used word, said document group and said word are to be utilized as said third search (refining search can be more than one) condition in said following processing (figs. 1, 2, 8).

Regarding Claim 14, Whitman discloses at least either of said first and second transforming comprises specifying a display program corresponding to a display form, and generating information for said display program (figs. 1, 2, 8).

Regarding Claim 16, Whitman discloses a computer readable medium storing instructions being executable by a processor to perform a method comprising:

- searching a predetermined document group according to a first search

    condition specified by a user to extract data of a plurality of documents

    from a storage that stores said predetermined document group (Fig. 8

    and Col. 1, lines 15-44, Col. 6, lines 1-15, Col. 6, lines 58-68; Col. 7,

    lines 1-12 and Col. 14, lines 13-22);

- transforming said data of said plurality of documents into information to

    indicate said data of said plurality of documents to said user in a first

    display form and to enable said user to select a display item to be utilized

    as second search condition in a following processing (refining the query,

    Col. 1, lines 53-62 and Col. 3, lines 39-55), and outputting the

    transformed information (810, 820) (Fig. 8 and Col. 7, line 59 to Col. 8,

    line 5 and Col. 14, lines 13-22);

- extracting data of documents corresponding to said display item selected

    by said user from the storage (133) or the data of the plurality of

    documents (Abstract and Col. 2, lines 25-40 and Col. 3, lines 39-57 and

    Col. 4, lines 1-7 and Col. 5, lines 44-64, Col. 6, lines 1-15); and

- transforming said data of said documents corresponding to said selected

    display item into information to indicate said data of said documents to

    said user in a second display form specified by said user (refining the

    query, Col. 1, lines 53-62 and Col. 3, lines 39-55) and to enable said user

    to select a display item to be utilized as a third search condition in a

    following processing ("refining" can be more than two) and outputting the

transformed information (810) (Fig. 8, and Col. 7, line 59 to Col. 8, line 5

and Col. 14, lines 13-22).

Regarding Claim 17, Whitman discloses that a first form showing indications of

extracted documents (recent set of query) that have been classified by used words

(search phrases previously-submitted) in said extracted documents (Col. 2, lines 13-40).

Regarding Claim 18, Whitman discloses a search processing apparatus,

comprising:

- a search unit that searches a predetermined document group according

to a first search condition specified by a user to extract data of a plurality

of documents from a storage (133) that stores the predetermined

document group (Fig. 8 and Col. 1, lines 15-44, Col. 6, lines 1-15, Col. 6,

lines 58-68; Col. 7, lines 1-12 and Col. 14, lines 13-22);

- a first transformer that transforms said data of said plurality of documents

into information to indicate said data of said plurality of documents to

said user in a first display form and to enable said user to select a display

item to be utilized as a second search condition a following processing

(refining the query, Col. 1, lines 53-62 and Col. 3, lines 39-55), and

outputs the transformed information (810, 820) (Fig. 8 and Col. 7, line 59

to Col. 8, line 5 and Col. 14, lines 13-22);

an extractor that extracts data (data extracted and displayed) of

documents corresponding to said display item selected by said user from

the storage (133) or the data of the plurality of documents (Fig. 8, Col. 6,

lines 1-15, and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22);

and

- a second transformer (refining the query, Col. 1, lines 53-62 and Col. 3, lines 39-55) that transforms said data of said documents corresponding to said selected display item into information to indicate said data of said documents to said user in a second display form specified by said user and to enable said user to select a display item to be utilized as a third search condition ("refining" can be more than two) in a following processing, and outputting the transformed information (Fig. 8 and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22).

Regarding Claim 19, Whitman discloses that a first form showing indications of extracted documents (recent set of query) that have been classified by used words (search phrases previously-submitted) in said extracted documents (Col. 2, lines 13-40).

Regarding Claim 20, Whitman discloses a method, comprising:

- extracting data selected by a user from a plurality of documents stored (stored as temporarily for the refinement search. Col. 1, lines 53-62 and Col. 3, lines 39-55) (And data can be stored in database 133 in Fig. 8) as a predetermined document group by searching the predetermined document group based on a search condition (Fig. 8, Col. 6, lines 1-29, and Col. 7, line 59 to Col. 8, line 5 and Col. 14, lines 13-22);

- transforming the data from the plurality of documents stored in the predetermined document group into information to the user that enables

the user to select a search result (select or click on the displayed items,

search results in fig. 8) as a following search condition to search the

predetermined document group based on the following search condition

and outputting a transformed search result. (Fig. 8, Col. 6, ines 1-29, Col.

7, lines 59 to Col. 8, line 5, Col. 14, lines 13-32).

Claim Rejections – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 13, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Whitman et al. (6,772,150).

Regarding Claim 13, Whitman does not explicitly disclose that a document

included in said predetermined document group is a patent document, and said display

item is either of bibliographic information of said patent document and a used word in

said patent document. However, since books and patents are both text documents. If

one can search books on a machine then one can surely search patents which is

technically reasonable. There is no technical different between books and patents

because they are both in text and image file. It would have been obvious to one of

ordinary skill in the art to upload patent documents to the database of the Whitman's

search engine to cover the usage in searching patent documents (e.g. bibliography) in
order to search the book author's (if the author is also inventor) possible invention.

Regarding Claim 15, although Whitman does not explicitly disclose an arbitrary
combination (any combination) of predefined display forms, however, rearranging the
location of the results and display the lists in any manner does not provide unexpected
and useful result. It would have been obvious to one of ordinary skill in the art to
display the result in any desired manner or form in order to attract the user's attention
based on a desired group (e.g. if user likes the section of Full Results appears first, it
could be placed above the section of Related Searches.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in
this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within
TWO MONTHS of the mailing date of this final action and the advisory action is not
mailed until after the end of the THREE-MONTH shortened statutory period, then the
shortened statutory period will expire on the date the advisory action is mailed, and any
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
the advisory action. In no event, however, will the statutory period for reply expire later
than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Wilson Lee whose telephone number is (571) 272-1824.

Papers related to the application may be submitted by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "DRAFT". The official fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wilson Lee
Primary Examiner
U.S. Patent & Trademark Office

12/23/07